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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,586	03/29/2002	Marco La Greca	205567-xxxx	2541

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EXAMINER

BOLDEN, ELIZABETH A

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 02/13/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/089,586

Applicant(s)

LA GRECA ET AL.

Examiner

Elizabeth A. Bolden

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 4 and 11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other:

## **DETAILED ACTION**

### ***Claim Objections***

Claims 4 and 11 are objected to because of the following informalities: minor typographical errors.

In line 1 of Claim 4, “anyone” should be corrected to read “any one”.

Claim 11 has the recitation “SO<sub>3</sub>: 0.1 to 0,5;” in line 11. The comma should be replaced with a period so that the range is “0.1 to 0.5;”.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9, 10, 13, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation “B<sub>2</sub>O<sub>3</sub>: less than 5”. Claim 9 depends from claim 6, which further depends from claim 5, wherein claim 5 recites “B<sub>2</sub>O<sub>3</sub>: 5-15;”. This renders the claim 9 indefinite since the B<sub>2</sub>O<sub>3</sub> range is not within the bounds of the B<sub>2</sub>O<sub>3</sub> range in claim 5.

Claim 10 recites the limitation “B<sub>2</sub>O<sub>3</sub>: less than 4.5”. Claim 10 depends from claim 9 then claim 6, which further depends from claim 5, wherein claim 5 recites “B<sub>2</sub>O<sub>3</sub>: 5-15;”. This

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renders the claim 10 indefinite since the B<sub>2</sub>O<sub>3</sub> range is not within the bounds of the B<sub>2</sub>O<sub>3</sub> range in claim 5.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 13 and 15 recite the broad recitation "MgO: higher than 3", and the claim also recites "MgO: preferably higher than 3.5", which is the narrower statement of the range/limitation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by De Meringo et al., U.S. Patent 5,952,254.

De Meringo et al. disclose an inorganic fiber where the composition is sufficiently specific to anticipate the compositional limitations of Claims 1-15. See column 4, 47-48, column 5, lines 20-30, column 6, lines 12-20 and 48-58, column 8, lines 61-65, and MPEP 2131.03.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of De Meringo et al. would inherently possess the same bio-solubility properties recited in claim 1. See MPEP 2112.

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Furtak, French Patent 2,781,788.

Furtak discloses an biodegradable fiber where the composition is sufficiently specific to anticipate the compositional limitations of Claims 1-15. See Derwent Abstract of Furtak and MPEP 2131.03.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al., U.S. Patent 5,401,693.

Bauer et al. teach a biosoluble glass fiber composition in mole percent. See column 6, lines 26-33.

It is believed that Bauer et al. teach a composition whose ranges overlap the compositional limitations of claims 1-15. See column 6, lines 26-33. Overlapping ranges have been held to establish *prima facie* obviousness. MPEP 2144.05.

Bauer et al. fail to teach any examples or compositional ranges that are sufficiently specific to anticipate the compositional limitations of claims 1-15. However, as noted above, overlapping ranges have been held to establish *prima facie* obviousness. MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the Bauer et al. because overlapping ranges have been held to establish *prima facie* obviousness.

### ***Conclusion***

The additional references cited on the 892 have been cited as art of interest since they are cumulative to or less than the art relied upon in the rejections above.

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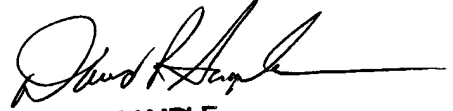
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 703-305-0124. The examiner can normally be reached on 8:30am to 6:00 pm with alternating Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 703-308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

EAB  
February 10, 2003

  
DAVID SAMPLE  
PRIMARY EXAMINER